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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,451	02/11/2002	James Carl Bedingfield	36968-169167 Cont.	5869

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Scott P. Zimmerman PLLC  
P.O. Box 3822  
Cary, NC 27519

EXAMINER
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YAO, KWANG BIN

ART UNIT	PAPER NUMBER
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2667

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/073,451	<b>Applicant(s)</b> BEDINGFIELD ET AL.	
	<b>Examiner</b> Kwang B. Yao	<b>Art Unit</b> 2667	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-38 and 41-46 is/are pending in the application.
- 4a) Of the above claim(s) 32-38 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-31 is/are allowed.
- 6) ☒ Claim(s) 41-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I in the reply filed on 1/19/05 is acknowledged. The traversal is on the ground(s) that no burden is present. This is not found persuasive because Inventions II and I are related as combination and subcombination. The combination as claimed does not require the particulars of the subcombination as claimed because Invention I and II have different mode of functions, operations and effects. The subcombination has separate utility such as the followings: the subcombination in Invention II has separate utility of activating an Internet call notification service by disclosing the claimed limitations of "causing the SSP to receive notice of initiation of internet session by the user" recited in claim 21; and the claimed limitations of "making a call on the line associated with the telephone number in a telephone network and with the call being directed to a pre-pended code and a number of an internet service provider so as to make an internet connection" recited in claim 41; and the claimed limitations of "receiving a communication associated with an address for voice communication in a voice communication network and with the communication being directed to an address of a data communication provider" recited in claim 43. See MPEP § 806.05(c). Since Inventions I and II have different mode of functions, operations and effects, Examiner must do different searches with respect to the different mode of functions, operations and effects. Thus, the burden does exist. The requirement is still deemed proper and is therefore made FINAL.

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2. This application contains claims 32-38 drawn to an invention nonelected with traverse filed 1/19/05. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 43, 45, 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Whittaker (US 6,125,177).

Whittaker discloses a communication system comprising the following features: regarding claim 43, receiving a communication associated with an address for voice communication (Fig. 3, step 45) in a voice communication network (Fig. 2, PSTN 12, 12') and with the communication being directed to an address of a data communication provider (Fig. 2, Internet Service Provider 14); in response to use of the address of the data communication provider (Fig. 2, Internet Service Provider 14) in the voice communication network (Fig. 2, PSTN 12, 12'), receiving an inquiry (Fig. 3, steps 54, 55) for an address for data communication of a user over a data network from a server (IDM 27) in the voice communication network (Fig. 2, PSTN 12, 12'); responding to the inquiry by sending the address (column 7, lines 54-55) for data communication of the user over the data network to the server (IDM 27), whereby the use of the address of the data communication provider (Fig. 2, Internet Service Provider 14) prompts the

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server (IDM 27) to request the address for data communication of the user (column 7, lines 47-52); regarding claim 45, wherein the address for voice communication is a telephone number (column 7, lines 14-16); regarding claim 46, wherein the address for data communication is an Internet Protocol address (column 7, lines 54-55). See column 5-11.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 41, 42, 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whittaker (US 6,125,177) in view Shtivelman et al. (US 6,078,581).

Whittaker discloses a communication system comprising the following features: regarding claim 41, receiving a call (Fig. 3, step 45) on the line associated with the telephone number in a telephone network (Fig. 2, PSTN 12, 12') and with the call being directed to a number of an internet service provider (Fig. 2, Internet Service Provider 14) so as to make an internet connection; receiving an inquiry (Fig. 3, steps 54, 55) for an internet protocol address of the user over a data network from a server (IDM 27) in the telephone network (Fig. 2, PSTN 12, 12'); and responding to the inquiry by sending the internet protocol address of the user (column 7, lines 54-55) over the data network to the server (IDM 27), whereby the call prompts the server (IDM 27) to setup the call notification service for the user, and whereby also prompts (column 7, lines 47-52) the server (IDM 27) to request the internet protocol address of the user so as to

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activate the call notification service; regarding claim 44, wherein the data communication provider (Fig. 2, Internet Service Provider 14) is an internet service provider, and the address of the data communication provider (Fig. 2, Internet Service Provider 14) includes a number of the internet service provider;

Whittaker does not disclose the following features: regarding claim 41, the call being directed to a pre-pended code and a number of an internet service provider so as to make an internet connection; whereby use of the pre-pended code in the call prompts the server to setup the call notification service for the user, and whereby the use of the pre-pended code also prompts the server to request the internet protocol address of the user so as to activate the call notification service; regarding claim 42, wherein the pre-pended code is a feature code; regarding claim 44, the address of the data communication provider includes a pre-pended feature code and a number of the internet service provider.

Shtivelman et al. discloses a communication system comprising the following features: regarding claim 41, the call being directed to a pre-pended code (column 3, lines 4-10) and a number of an internet service provider so as to make an internet connection; whereby use of the pre-pended code (column 3, lines 4-10) in the call prompts the server to setup the call notification service for the user, and whereby the use of the pre-pended code (column 3, lines 4-10) also prompts the server to request the internet protocol address of the user so as to activate the call notification service; regarding claim 42, wherein the pre-pended code (column 3, lines 4-10) is a feature code; regarding claim 44, the address of the data communication provider includes a pre-pended feature code and a number of the internet service provider (column 3, lines 4-10). See column 3-8. It would have been obvious to one of the ordinary skill in the art at the

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time of the invention to modify the system of Whittaker by using the features, as taught by Shtivelman et al., in order to alleviate inconvenience and concern associated with the inability to receive possibly important telephone calls while on-line. See Shtivelman et al., column 2, lines 23-27.

***Allowable Subject Matter***

7. Claims 21-31 are allowed.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Creamer et al. (US 6,028,917) discloses a communication system.

Foladare et al. (US 5,982,774) discloses an Internet on hold system.

Norris et al. (US 5,805,587) discloses a call notification system.

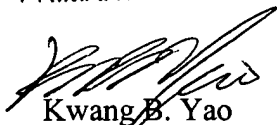
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwang B. Yao whose telephone number is 571-272-3182. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi H. Pham can be reached on 571-272-3179. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**KWANG BIN YAO**  
**PRIMARY EXAMINER**



Kwang B. Yao  
May 20, 2005